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Patent Law Analysis by Professor Dennis Crouch

Jun 25, 2008

Ex Parte Reexamination Statistics II

To get some sense of the PTO's current *ex parte* reexamination practice, I looked at the 2000+ reexamination certificates that have been published in the Official Gazette since January 2000. There are three potential outcomes for any particular reexamined claim: validity affirmed; validity affirmed with an amendment; and cancelled. In addition, claims may be added.

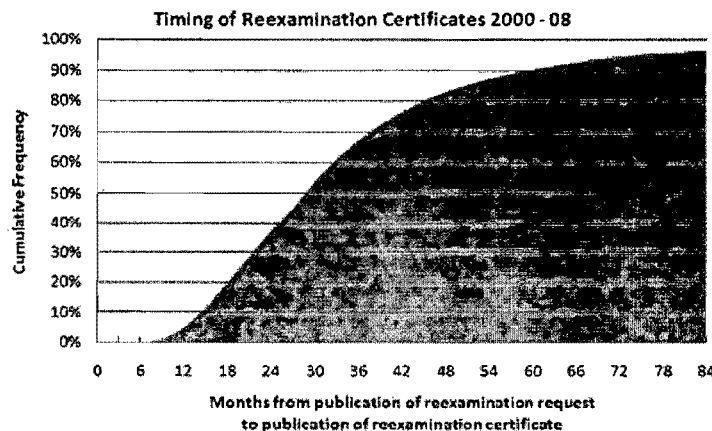
Outcomes: From my sample, 71% of the completed reexaminations resulted in claims that were either amended or cancelled while only the remaining 29% resulted in all claims being confirmed. A much smaller number – 12% – of the reexaminations resulted in all claims being cancelled.

The middle ground: 59% had at least one independent claim confirmed while 50% included at least one amended claim. For the 34 completed design patent reexaminations, the single claim was confirmed as valid 16 times and cancelled 18 times.

Timing: The reexamination certificates in my sample had an average pendency of 33.5 months (median 28.5 months).* The PTO's reported average and median are 24.0 months and 18.6 months respectively. The difference apparently comes from their inclusion of reexaminations from the 1980's and 1990's which had much lower pendency than more recent numbers. [PTO Data 1981-2007].

Outcome & Timing: Reexaminations that simply resulted in a confirmation that the the initial claims are valid were resolved more quickly (averaging 24 months) while those resulting in cancellation of all claims were much slower (averaging 45 months). Cases at the longer end of the spectrum often involved either BPAI appeals or lost files.

Reexamination Results



- Thanks to several Patently-O readers for showing me how to find reexamination certificates. I was able to use the Westlaw database for this search. (Remember law school and the free academic access). The data can be compiled from the PTO OG, but that would be a larger job. The PTO does maintain a list of all the issued reexamination certificates [here](#).
- * I roughly calculated pendency by measuring the elapsed time from publication of a reexamination request to publication of the reexamination certificate.
- [Reexamination Statistics I](#)

EXHIBIT B

Posted on Jun 25, 2008 at 06:40 AM in [Academic Studies](#), [Reexamination](#) | [Permalink](#)
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Comments

anonymouseAgent said...

Dennis,

Do you have enough data to compare pre-KSR statistics with post-KSR statistics - is there a trend, since KSR, of re-examinations resulting in more claims being cancelled? If yes, how strong of a trend.

[Reply Jun 25, 2008 at 08:33 AM](#)

J. D. said...

Do you have any statistics on the percentage of Federal District Court stays granted in light of a pending reexamination (both ex-parte and inter-partes)?

[Reply Jun 25, 2008 at 10:35 AM](#)

M. Slonecker said...

Any similar data re inter parties reexam?

[Reply Jun 25, 2008 at 01:45 PM](#)

anon too said...

and of course, why doesn't the PTO publish these and other useful statistics?

[Reply Jun 25, 2008 at 02:07 PM](#)

The Mad Prosecutor said...

Anon Too:

Because that would encourage people to obtain patents. And as the Rejection Office has stated, they don't want to encourage that (please reference their previous comments regarding no longer releasing statistics on number of patents issued by assignee).

[Reply Jun 25, 2008 at 02:57 PM](#)

Jam said...

Why is the pendency measured from the date of publication of the reexamination request instead of from the date of submission of the reexamination request? Isn't that of greater concern?

Apparently, the PTO is so proud of publishing the reexamination requests so soon. (It believe it deserves credit for complying with the statute.) It's too bad it takes so long to complete the process.

[Reply Jun 26, 2008 at 03:46 AM](#)

Paul F. Morgan said...

Thank you for reconfirming other studies demonstrating that the PTO allegation last year of only a two year average pendency for reexaminations is simply not true. Especially after necessarily adding on the additional PTO delays from the filing of the reexam request until its publication.

[It is inexcusable that patent reexaminations, which were intended by Congress to reduce and expedite patent litigation, should be taking the USPTO longer to act on than ordinary LOW priority patent applications. The PTO demonstrated in the RIM {Blackberry} patents litigation that it is capable of doing a reexamination office action in as little as 4 days, yet, as shown, a huge number of reexaminations have been delayed by the PTO for years, including almost ALL inter partes reexaminations. The reexamination system does not allow any significant delays by applicants, so essentially all these delays are due to PTO managagement failures to properly prioritize this highly publicly important reexamination work, and reissues, both of which are vastly fewer than normal applications.]

[Reply Jun 26, 2008 at 11:25 AM](#)

Paul F. Morgan said...

35 USC 305 - "Conduct of reexamination proceedings" - clearly states: "All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office."

How can the above PTO reexamination pendency statistics be viewed as other than a gross PTO violation of this statutory "special dispatch" requirement?

[Reply Jun 26, 2008 at 11:41 AM](#)

Paul F. Morgan said...

Here is today's apt comment on these reexam pendency statistics by Prof. Wegner:

"All ex parte patent reexaminations pending for more than two years were processed to final determination." That's what the PTO claims in its latest Annual Report. Statistics released on June 25, 2008, by Professor Dennis Crouch paint an entirely different picture.

Nearly Eight (8) Years Pendency for Reexams that Reach the Federal Circuit: For important reexaminations – measured by those that reach the Federal Circuit – the average pendency approaches eight (8) years."

[Reply Jun 26, 2008 at 04:45 PM](#)

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Professor Crouch is Associate Professor of Law at the University of Missouri School of Law. Prior to joining the MU Law Faculty, he was a patent attorney at McDonnell Boehnen Hulbert & Berghoff LLP in Chicago, Illinois, and taught at Boston University Law School. He has worked on cases involving various technologies including computer memory and hardware, circuit design, software, networking, mobile and internet telephony, automotive technologies, lens design, bearings, HVAC systems, and business methods. He is also the editor of the popular patent law weblog: [Patently-O](#).

- Patent Law

Professor Crouch received his BSE in mechanical engineering *cum laude* from Princeton University, where he also earned a certificate in engineering management systems. He then earned his JD *cum laude* from the University of Chicago Law School. While at the University of Chicago, he was a Microsoft, Merck, & Pfizer scholar and a member of the Olin program in law and economics.

Prior to attending law school, Professor Crouch worked as a technical consultant for manufacturing firms in New England, as a research fellow at NASA's Glenn Research Center, as a software developer at the Mayo Clinic's department of biomedical imaging, and as a Peace Corps Volunteer in Ghana, West Africa. Dennis Crouch grew up on a farm near Pittsburg, Kansas.

Recent Publications

Academic Journals

A Trademark Justification for Design Patent Rights, 24 HARVARD JOURNAL OF LAW AND TECHNOLOGY (forthcoming 2011).

| [SSRN](#) |

Book Review: Reviewing Part III of Innovation for the 21st Century: Harnessing the Power of Intellectual Property and Antitrust Law, 61 ALABAMA LAW REVIEW 587 (2010).

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An Empirical Study of the Role of the Written Description Requirement in Patent Prosecution, 104 NORTHWESTERN UNIVERSITY LAW REVIEW COLLOQUY 382 (2010).

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Is Novelty Obsolete? Chronicling the Irrelevance of the Invention Date in U.S. Patent Law, 16 MICHIGAN TELECOMMUNICATIONS AND TECHNOLOGY LAW REVIEW 53 (2009).

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The Patent Lottery: Exploiting Behavioral Economics for the Common Good, 16 GEORGE MASON LAW REVIEW 141 (2008).

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Additional Publications

Broadening Federal Circuit Jurisprudence: Moving Beyond Federal Circuit Patent Cases, 2010 PATENTLY-O PATENT LAW JOURNAL 19 (2010).

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Working Papers

Understanding the Role of the Board of Patent Appeals: Ex Parte Rejection Rates on Appeal, University of Missouri School of Law Legal Studies Research Paper No. 2009-16 (2009).

| [SSRN](#) |

The Rising Size and Complexity of the Patent Document, U of Missouri-Columbia School of Law Legal Studies
Research Paper No. 2008-04 (2008)

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